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10/533,150	04/27/2005	Takayuki Taguchi	10921.315USWO	2382
52835	7590	12/04/2009	EXAMINER	
HAMRE, SCHUMANN, MUELLER & LARSON, P.C. P.O. BOX 2902 MINNEAPOLIS, MN 55402-0902			LEVKOVICH, NATALIA A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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DEC 04 2009

Mailed:

In re application of

Taguchi et al.

Serial No. 10/533,150

Filed: April 27, 2005

For: Analyzing Tool And Device

**DECISION ON
PETITION**

This is a response to a PETITION UNDER RULE 37 C.F.R. 1.181 (no fee) filed October 21, 2009 requesting that the Examiner enter Applicant's Amendment of January 8, 2009 and to also request a stay of prosecution until a decision regarding this petition is reached.

A Notice of Non-Compliant Amendment was mailed on April 6, 2009 in response to Applicants' Amendment of January 8, 2009 and the second Notice of Non-Compliant Amendment mailed on September 21, 2009 was in response to Applicants' response to the Notice mailed on June 8, 2009.

The January 8, 2009 Amendment amended claims 1-3, 5, 7, 8 and 10-12 and cancelled claim 4. This amendment was filed in response to the non-final office action that was mailed July 8, 2008. The Examiner's basis for non-entry of the amendment was that claims 1-3 and 5-12 as now presented are directed to an invention that is independent or distinct from the invention of the original claims 1-12 and that the invention of original claims 1-12 have been constructively elected by original presentation for prosecution on the merits.

The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application. Subsequently presented claims to an invention other than that acted upon should be treated as provided in MPEP § 821.03.

821.03 Claims for Different Invention Added After an Office Action

Claims added by amendment following action by the examiner, MPEP § 818.01, § 818.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145.

37 CFR 1.145 Subsequent presentation of claims for different invention.

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

The Examiner asserts the original claims were drawn to a single species that is currently removed by the Applicant in the latest amendment. Applicant states that the originally filed claim 1 was broad enough in scope to cover the features added in the latest amendment. The

Examiner agrees that claim 1, was broad and not directed to Species II at the time of the first action on the merits. The Examiner asserts that the features of Species II were added later, after the first action on the merits, while the features of Species I, were removed from all the dependent claims.

37 CFR § 1.146 Election of species.

In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application.

It is noted that original claims 1-12 were examined without requiring Applicants to elect a species.

DECISION

The Petition is **GRANTED**.

Original claim 1 is generic to the amended claim 1 and broad enough to cover Species I and Species II.

The Examiner is directed to enter the amendment.

/Gregory L Mills/

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